

REMARKS

Overview

Claims 1-11, 13-15, 17-22 and 25-27 are pending in the present application. Claim 27 is new. The present response is an earnest effort to place the claims in proper form for allowance.

Claim Rejections Under 35 U.S.C. § 103

Claims 1-7, 9-11, 13-16, 21-23 and 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Danneels in view of Dworkin. These rejections are respectfully traversed.

Danneels discloses a dynamic linking of supplier web sites to reseller web sites in the context of electronic commerce. Danneels discloses a purchaser being able to select items at its supplier's web site and being able to transfer the list of selected items to a reseller's web site without having to enter the information a second time.

Dworkin is a system that gathers information about what suppliers are available for specific item and then fills the customer's needs with the item at the best price.

Neither reference addresses precisely the same problem as addressed by the present invention -- wanting to increase the likelihood that a sale referred to an online partner is consummated. Danneels refers a sale to an online partner, but loses control. Dworkin controls the process completely. Neither solution solves the problem identified and resolved by the claimed invention. The fact that neither reference recognizes or solves the same problem as the claimed invention does is evidence of non-obviousness. This is clear from numerous cases including In re Wright, 6 U.S.P.Q.2d 1959 (Fed. Cir. 1988) ("The problem solved by the invention is always relevant"); In re Bishay, 94 U.S.P.Q. 80 (CCPA 1952) ("The discovery of a problem calling for an improvement is often a very essential element in an invention correcting

such a problem. Though the problem, once realized, may be solved by use of old and known elements, this does not necessarily negate patentability").

The present invention provides significant and substantial benefits over Danneels. The terminology often used throughout the present application to describe the present invention is "cart transfer". This terminology connotes that the buying decision has been made and a consumer is ready to check out.

The present invention provides for presenting information on the manufacturer web site sufficient for a consumer to make a buying decision before the consumer leaves the manufacturer web site. By controlling the presentation of this information and making it available on the manufacturer web site, the consumer can make the buying decision on the manufacturer web site, yet still visit a reseller web site to consummate the sale.

Danneels et al., as the Examiner recognizes, does not disclose providing pricing information for the reseller on the supplier's web site. Pricing is one key buying criteria for whether to buy a particular item, and where to buy the item from. Because Danneels does not allow for pricing of different reseller web sites to be viewed at the supplier's web site, Danneels, does not control the buying process. Danneels assists in the buying process and Danneels monitors the buying process, but Danneels does not control the buying price. That fact that Danneels receives feed back from the reseller web site (column 5, lines 44-48) evidences that Danneels fails to control the buying process by not providing sufficient information on the supplier web site for the consumer to make a buying decision prior to leaving the supplier web site.

Danneels makes no recognition of the fact that once a consumer is transferred to the reseller web site, the consumer may change their mind and select an alternative product from the

reseller web site if the price for the selected product is too high instead of returning to the supplier web site. Should that happen, the supplier loses a sale because the buying process was not a guided or controlled buying process. The supplier web site simply cannot control the buying process without providing sufficient information such as price on the supplier web site.

Claim 1 requires the limitation of "the first web site being further adapted to display a price of the product purchase selection prior to transferring the product purchase selection to the shopping cart of the second web site to thereby assist consumers in making purchasing decisions prior to leaving the first web site." Neither Danneels nor Dworkin disclose this limitation, therefore, this rejection must be withdrawn. It is respectfully submitted that this limitation makes clear that the first web site provides pricing information to facilitate the consumer/purchaser making an informed decision without needing to leave the first web site.

Compare this language of claim 1 with the teaching of Danneels. At col. 3, lines 67 to col. 4, line 6, Danneels discloses that the prices are shown at the second web site and not the first web site:

"In block 120, the purchaser actually purchases the items that were previously selected at the supplier's web site. In one embodiment, this can entail the purchaser being shown a list of the items that were previously selected, along with prices thereof, such that the purchaser has the opportunity to change quantities of the items to be purchased."

Referring to FIG. 1 and step 120 of Danneels, note that this step and therefore the showing of prices is performed at a reseller's site 104 and not a supplier's site 102.

Dworkin discloses an automated system to assist a user in locating and purchasing goods or services sold by a plurality of vendors (Abstract). Dworkin discloses a system that shows the user the names of the suppliers from whom a product or service can be obtained and prices

available from each supplier (col. 2, line 27-31). Dworkin further discloses that a product or system is ordered through the system:

"The user can then order a product through the system by selecting one of the retrieved products by its identifier. The system prompts the user for the information necessary to complete the transaction. The system then generates the appropriate documents for recording the transaction, and if necessary, forwards the documents to the selected supplier. The order can also be transmitted to the supplier electronically." (Col. 2, line 34-41).

Thus, in Dworkin, the user only interacts with a single system. The user is not shared, because the user only directly interacts with one system.

Neither Danneels nor Dworkin disclose that price is presented to a user on a first web site and directing a user to a second web site where the user completes the order. In Danneels, the user is directed to the second web site and price is shown on the second web site. In Dworkin, the user only communicates with a single automated system and never interacts with a second automated system, let alone a second web site. Thus, neither reference alone or in combination teach or suggest "the first web site being further adapted to display a price of the product purchase selection prior to transferring the product purchase selection to the shopping cart of the second web site to thereby assist consumers in making purchasing decisions prior to leaving the first web site."

Claim 1 describes a technical solution which fundamentally alters the buying process in a manner that allows the first web site to maintain greater control over the buying process. Access to a customer is shared between a first web site and a second web site, but the buying process is guided by the first web site to reduce the likelihood of losing the sale. In particular, the consumer makes the decision whether to buy or not on the first web site, and manifests this decision by placing the product selection in the cart. Before leaving the first web site, the

consumer knows what the price will be. Thus, because the first web site manages the buying process, there is less likelihood of losing a sale of the product once selected. Consider what could happen if the first web site does not control the buying process in the claimed manner. A would-be purchaser of a product could be directed to a second web site and because pricing was unsatisfactory select a different product which could even be a product not available on the first web site. For example, a consumer could visit the first web site and select a MAYTAG® appliance. A consumer could then be directed towards a second web site such as a Sears web site. If the consumer was not content with the price of the MAYTAG® appliance, the consumer could potentially select a different brand of product at the Sears web site -- one not even associated the first web site (i.e. a non-Maytag appliance). By providing pricing information on the first web site, consumers are only directed towards the second web site once they are ready to make the purchase -- after reviewing pricing information and placing the purchase in their cart. This methodology increases the likelihood that a consumer who comes to a MAYTAG web site to buy an appliance, ultimately buys a MAYTAG appliance even though the consumer is ultimately directed towards a second web site to complete the sale.

This further provides for there to be a relationship between the first web site and the second web site which is mutually beneficial to both the first web site and the second web site as channel conflict issues are addressed and direct access to the customer is shared in the sense that the customer visits both the first web site and the second web site, yet **in a manner that assists in maintaining the sale of a product selected on the first web site.** The methodology of Danneels does nothing to assist in maintaining the sale of the product selected on the first web site. Danneels is silent on this point, despite the fact that Danneels recognizes that sales will be lost when a customer is linked from the first web site to a second web site as Danneels discloses

tracking a success rate of how many would-be purchasers actually purchased items (co. 4, line 12-15).

Even if Dworkin was extended to the context of web sites, the methodology of Dworkin does not provide the proprietor of the second web site with direct access to the customer which is a detriment to the proprietor of the second web site. Therefore neither Danneels nor Dworkin alone or in combination disclose all the limitations of claim 1. The Examiner's position parses the language of the claims in a manner which artificially divides meaningful limitations, without respect to the context of the claims or the prior art. Moreover, any combination of these references is merely based on improper hindsight as no convincing line of reasoning is articulated.

The Examiner indicates that:

It would have been obvious to one of ordinary [sic] skill in the art at the time of the invention [to] modify the information entered by the reseller and presented to purchasers of Danneels to include information about price, specification (policies) and availability as taught by Dworkin. One of ordinary skill in the art would have been motivated to modify the references in order to greatly reduce the amount of time required in shopping for products" (Office action, p. 5, lines 6-10).

There are a number of problems with this purported motivation or suggestion to combine, which is actually mere hindsight reconstruction. Most of these problems stem from the fact that the Examiner is basing the purported motivation or suggestion to combine on the perspective of a customer. From the customer perspective, if one wanted to greatly reduce the amount of time required in shopping for products, would it not be the case that one would merely use only one web site (the first web site) and allow the customer to order directly from the first web site? For example, allowing the customer to order directly from the manufacturer? If the purpose was merely to greatly reduce the amount of time required, wouldn't one just use the Dworkin system?

The alleged combination is nothing more than improper hindsight reconstruction and must be withdrawn.

Moreover, Danneels and Dworkin both provide complete solutions to the problems they address. To the extent that the Examiner is combining these references, it is respectfully submitted that the Examiner is merely applying improper hindsight. "When prior-art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination." *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). Here, when the prior art is taken as a whole, there is no proper basis to combine the references in a manner which would yield the claimed invention. Therefore, it is respectfully submitted that this rejection to claim 1 must be withdrawn. As claims 2-7 and 9 depend from claim 1, these rejections should also be withdrawn.

Independent claim 10 requires the limitation "providing an online consumer with a web site having a view of a first shopping cart containing one or more product purchase selections and adapted for displaying pricing of the one or more product purchase selections to thereby assist the online consumer with making a purchasing decision prior to leaving the web site". It is respectfully submitted that this limitation makes clear that the pricing information is available to the consumer before the consumer transfers the information from the first web site to the shopping cart of the second web site. Thus, the consumer has all of this information before ever having to visit one or more customer web sites, yet is still transferred to a customer web site. Neither Danneels nor Dworkin disclose such limitations. Moreover, this difference is significant

because it enables the first web site to better manage the buying/selling process, while still handing off the customer to the second web site.

The consumer is drawn to the first web site, thus, it should be possible to capture the sale of a product listed on the first web site. However, by sending a consumer to another web site, one would give up control. The present invention allows the first web site to manage enough of the buying/selling process prior to transferring the customer to another web site to avoid giving up the sale. In other words, sufficient information is presented to the consumer on the first web site to allow the consumer to make a definite buying decision. Therefore this rejection to claim 10 should be withdrawn. As claims 11, 13 and 14 depend from claim 10, it is respectfully submitted that these rejections should also be withdrawn.

Claim 15 includes the limitation of "a manufacturer web site adapted to communicate product information sufficient for consumers to make product purchasing decisions without leaving the manufacturer web site, adapted to communicate product pricing to consumers and adapted to receive product purchase selection information from the consumer". The limitation distinguishes over the combination of Danneels and Dworkin in that the first web site displays pricing information before the transfer of the shopping cart from the first web site to the shopping cart of the second web site. Neither Danneels nor Dworkin disclose such a limitation. It is respectfully submitted this rejection to claim 15 should be withdrawn on this basis. Moreover, claim 15 requires "wherein the product purchase selection information comprises a product identifier and user information." This limitation further distinguishes both Danneels and Dworkin in that neither disclose the user information being transferred. Therefore this rejection should be withdrawn for this independent reason.

Claim 21 includes the limitation "providing pricing information for the product purchase selection on the manufacturer web site." As neither Danneels nor Dworkin disclose providing pricing information on the manufacturer web site, this limitation must also be withdrawn. As claims 22 and 23 depend from claim 21, it is respectfully submitted that these rejections should also be withdrawn. Claim 21 further distinguishes over both Dworkin and Danneels in that neither reference discloses receiving sufficient information from a consumer to complete a transaction on the manufacturer web site and transferring the information to a retailer web site.

Claim 25 requires "maintaining current product information" to thereby make clear one of the benefits of the relationship between a web site and online partner web sites. Namely, current product information need not be maintained on every online partner web site as the consumer makes a purchasing decision on the web site before being transferred to an online partner web site. Therefore, it is respectfully submitted that this rejection to claim 25 be withdrawn. As claim 26 depends from claim 25 this rejection should also be withdrawn.

Claim 26 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Danneels in view of Dworkin as applied to claim 1 above and in further view of Admitted prior art. The deficiencies of the combination of Danneels in view of Dworkin have already been discussed with respect to claim 1. It is respectfully submitted that this rejection should be withdrawn on that basis.

Claims 17-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Danneels in view of Greszberg et al. (hereinafter "Greszberg"). The Examiner recognizes that Danneels does not disclose "receiving a zip code from the online consumer" nor "each of the customers being authorized for delivery and installation of the at least one product purchase selection to the

zip code." Therefore, the Examiner turns to Gerszberg. Gerszberg provides for identifying pizza companies able to deliver to an address of a user (col. 9, lines 19-65).

The purported motivation or suggestion to combine Danneels with Gerszberg is "to provide consumers a simple process for ordering goods and services as taught by Gerszberg." (Office Action, p. 8). Again, the Examiner's purported motivation or suggestion to combine comes from a customer convenience standpoint. Such a motivation or suggestion to combine is improper, as if that was the objective to accomplish, then like in Gerszberg, a single system would be used to provide for ordering. The invention of claim 17 allows both the first web site and the second web site to interact with and therefore share the same customer, and neither Danneels nor Gerszberg discloses the dynamics for such a relationship. Absent any convincing line of reasoning to combine the references, it appears that the Examiner is merely relying on impermissible hindsight.

As claim 18 depends from claim 17, it is respectfully submitted that the rejection should be withdrawn.

Claim 19 includes the limitation of "receiving at least one product purchase selection and a zip code on the manufacturer web site." As previously discussed, and the Examiner recognizes, Danneels does not disclose the inclusion of a zip code in the first web site. In addition, for the reasons previously expressed, the Examiner has not provided a proper motivation or suggestion to combine or any convincing line of reasoning to combine Danneels and Gerszberg. Therefore, this rejection should also be withdrawn for the reasons expressed with respect to claim 17.

Claim 8 has been rejected as unpatentable over Danneels in view Dworkin as applied to claim 1 and further in view of the of Microsoft Computer Dictionary. As claim 8 depends from claim 1 and the Microsoft Computer Dictionary does not remedy the deficiencies of the

combination of Danneels and Dworkin, it is respectfully submitted that this rejection to claim 8 should be withdrawn.

Claim 20 had been rejected under 35 U.S.C. § 103(a) as being unpatentable over Danneels in view of Gerszberg as applied to claim 19 and further in view of Applicant's Disclosure. As claim 20 depends from claim 19, it is respectfully submitted that this rejection be withdrawn for the reasons expressed with respect to claim 19.

New Claim

Claim 27 is new. New claim 27 is similar to claim 10 but with additional language to provide additional context. No new matter is provided as should be clear at least from the original Specification, page 10, lines 10-28.

Conclusion

It is respectfully submitted that all rejections have been overcome and that all claims are in proper form for immediate allowance. Reconsideration is respectfully submitted. This Amendment accompanies a Request for Continued Examination (RCE). Please charge Deposit Account No. 26-0084 the amount of \$790.00 per the attached Request for Continued Examination Transmittal.

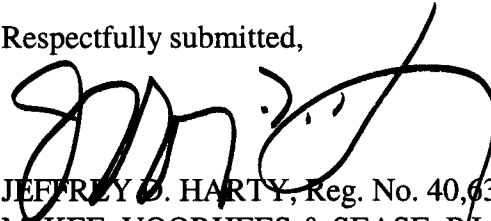
Please also charge Deposit Account No. 26-0084 the amount of \$250 for one additional claim over 20 and one additional independent claim over 3.

A one-month extension of time from September 21, 2006 to October 21, 2006 is requested, therefore, please also Charge Deposit Account No. 26-0084 the amount of \$120.00 for this extension. No other fees or extensions of time are believed to be due in connection with this

amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. Harty', is written over the typed name.

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